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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,198	05/01/2007	Peter Isberg	43315-226459	7494

26694 7590 01/21/2010

VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER	
ESTRADA, ANGEL R	
ART UNIT	PAPER NUMBER
2831	

MAIL DATE	DELIVERY MODE
01/21/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/564,198	ISBERG ET AL.	
	Examiner	Art Unit	
	Angel R. Estrada	2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 September 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/24/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 2, 5, 12 and 14 is withdrawn in view of the newly discovered reference(s) to Miggins (US 4,500,745). Rejections based on the newly cited reference(s) follow.

Information Disclosure Statement

2. The information disclosure statement filed September 24, 2009 has been considered by the Examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-13 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Miggins (US 4,500,745).

Regarding claim 1, Miggins discloses a bushing (10) for an electrical device, comprising an insulating core (28) comprising an exterior surface; and a continuous diffusion barrier (column 3 lines 16-53, epoxy resin) at least partially covering the exterior surface of the insulating core (28), the continuous diffusion barrier comprising a continuous film with firm adhesion to the insulating core (column 3 lines 16-53).

Regarding claim 2, Miggins discloses a bushing (10) for an electrical device, comprising an insulating core (28) is hollow and that at least part of the inside of the insulating core is coated with the diffusion barrier (column 3 lines 16-53, the core is coated with an epoxy resin).

Regarding claim 3, Miggins discloses the bushing (10), wherein the insulating core (28) comprises a body of epoxy resin impregnated paper (column 3 lines 16-53).

Regarding claim 4, Miggins discloses the bushing (10), further comprising: an outer hollow insulator (12) arranged outside the insulating core (28) and wherein at least a part of the outer hollow insulator (12) is coated with the diffusion barrier (see figure 1).

Regarding claim 6, Miggins discloses the bushing (10), wherein the diffusion barrier (28) comprises at least one of the following, an organic film or an organic/inorganic hybrid film (column 3 lines 16-53).

Regarding claim 7, Miggins discloses the bushing (10), wherein the diffusion barrier (28) comprises a multi-layer film (see figure 1, column 3 lines 16-53).

Regarding claim 8, Miggins discloses the bushing (10), wherein the diffusion barrier (28) comprises particles of hybrid or inorganic nature (see figure 1, column 3 lines 16-53).

Regarding claim 9, Miggins discloses the bushing (10), wherein the diffusion barrier (28) has a coefficient of water permeability smaller than 0.1 $g.m^{-1}.day\text{-}^{1}$ (column 3 lines 16-53).

Regarding claim 10, Miggins discloses the bushing (10), wherein the diffusion barrier (28) is deposited on at least part of the insulating core (1) and/or the outer hollow

insulator (2) by one of the following methods,: dipping, painting, spraying, plasma arc, sol-gel technology, Physical Vapor Deposition or Chemical Vapor Deposition (see figure 1).

Note: the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation "following methods: dipping, painting, spraying, plasma arc, sol-gel technology, Physical Vapor Deposition or Chemical Vapor Deposition" has not been given patentable weight.

Regarding claim 11, Miggins discloses a method for manufacturing a bushing (10) for an electrical device, the bushing (10) comprising an insulating core (28) the method comprising: coating at least a part of the insulating core (28) with a continuous diffusion barrier (column 3 lines 16-53, epoxy resin) comprising a continuous film with firm adhesion to the insulating core (column 3 lines 16-53).

Regarding claim 12, Miggins discloses the method, wherein the insulating core (28) is hollow, and wherein at least part of the inside of the insulating core is coated with the diffusion barrier (column 3 lines 16-53, the core is coated with an epoxy resin).

Regarding claim 13, Miggins discloses the method, further comprising: arranging an outer hollow insulator (12) outside the insulating core (28) and coating at least a part of the outer hollow insulator (12) with the diffusion barrier (column 3 lines 16-53, the core is coated with an epoxy resin).

Regarding claim 15, Miggins discloses the method (see figure 1) wherein the insulating core (28) and/or the outer hollow insulator (12) is coated with the diffusion barrier (column 3 lines 16-53; epoxy resin) comprising at least one of the followings: an inorganic film, an organic film or an organic/inorganic hybrid film (column 3 lines 16-53).

Regarding claim 16, Miggins discloses the method wherein the insulating core (28) is coated with a diffusion barrier comprising a multi-layer film (see figure 1, column 3 lines 16-53).

Regarding claim 17, Miggins discloses the method, wherein depositing the diffusion barrier is deposited on at least part of the insulating core (28) and/or the outer hollow insulator (9), by one of the following methods: painting, dipping, spraying, plasma arc, sol-gel technology, Physical Vapor Deposition or Chemical Vapor Deposition (see figure 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miggins (US 4,500,745).

Regarding claim 5, Miggins discloses the claimed invention except for the whole surface of the outer hollow insulator being coated with the diffusion barrier. It would have been an obvious matter of design choice to make the diffusion barrier larger so it can cover the whole surface of the outer insulator, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 14, Miggins discloses the claimed invention except for the whole surface of the outer hollow insulator being coated with the diffusion barrier. It would have been an obvious matter of design choice to make the diffusion barrier larger so it can cover the whole surface of the outer insulator, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Response to Arguments

5. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication should be directed to Angel R. Estrada at telephone number (571) 272-1973. The Examiner can normally be reached on Monday-Friday (8:30 -5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) OR 571-272-1000.

January 6, 2010.

/Angel R. Estrada/
Primary Examiner, Art Unit 2831